

REMARKS

Claims 1, 4 – 12, 14 – 15, 18 – 23, 25 – 26, 29 – 30, and 32 – 34 are pending. Claims 1, 15, 26, 33, and 34 are amended herein. Thus claims 1, 4 – 12, 14 – 15, 18 – 23, 25 – 26, 29 – 30, and 32 – 34 are pending and presented for examination. In view of the following remarks, Applicant requests further examination and reconsideration. No new matter has been added.

Support for the amendments can be found throughout the specification, including paragraphs 0016 – 0018 and 0022. No new matter has been added.

Claim Rejections under 35 USC 103

Claims 1, 4 – 12, 14 – 15, 18 – 23, 25 – 26, 29 – 30, and 32 – 34 are rejected under 35 USC 103(a) as being unpatentable over *Eder* (U.S. Pat. 7,580,848) in view of *D'Alessandro* (U.S. Pat. No. 6,556,974). The Applicant respectfully traverses the rejection and respectfully submits that the applied references do not teach, suggest, or disclose either individually or in combination the claimed features. Applicant submits that the combination of the cited references would not render the subject matter of the amended claims obvious to one of ordinary skill in the art. Applicant respectfully requests that the Office withdraw the rejection under 35 USC 103.

I. SCOPE AND CONTENT OF THE CITED ART

Obviousness under 35 U.S.C. Sec. 103 is "a legal conclusion based on factual evidence." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed.Cir.1983). The first step in an obviousness analysis is to determine the scope and content of the prior art. In determining the scope and content of the prior art, the teachings of the references must be examined. Applicant provides the following brief discussion of the cited art for consideration.

Eder describes and teaches a method and system for business valuation [Col. 1, lines 22 – 23]. It describes valuating both tangible and intangible assets [Col. 6, lines 7 – 9] to measure financial performance [Col. 4, lines 45 – 49]. It extracts financial data concerning revenue, expenses, capital, and elements of value [Col. 8, lines 4 – 7]. It does not describe or teach any particular means used for such extraction, nor does it describe or teach any distinction between qualitative or quantitative/numerical data. It does not describe or teach any distinction between

financial and business data. One skilled in the art would only glean from *Eder* that an enterprise needs to extract both tangible (income, profit, expenses, etc.) and intangible (intellectual property assets) financial data when valuing a company.

D'Alessandro describes and teaches a survey/interview method [Col. 1, lines 7 – 8, Col. 2, line 63] that surveys employees [Col. 3, line 33] and non-employees [Col. 3, line 59] about business performance [Col. 3, line 67] and then quantifies the results of the survey [Col. 4, line 4]. It further describes a total quality scorecard based on the Malcolm Baldrige criteria. The only means described for obtaining data is the survey method using questions; there are no data extraction techniques described or suggested. Moreover, it does not describe or teach any distinction between financial data, business data, qualitative data, or quantitative data. One skilled in the art would only glean from *D'Alessandro* that an enterprise can survey its employees, compile the results to determine performance of the business.

II. DIFFERENCES BETWEEN THE CITED ART AND THE CLAIMED INVENTION

The second step in the obviousness analysis is to determine the differences between the prior art and the claimed invention. Ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, see MPEP § 2111, and considering both the invention and the prior art as a whole. See MPEP § 2141.02. Office personnel must obtain a thorough understanding of the invention disclosed and claimed in the application by reading the specification, including the claims, to understand what the applicant has invented. See MPEP § 904. The scope of the claimed invention must be clearly determined by giving the claims the "broadest reasonable interpretation consistent with the specification." See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.

Each of the independent claims has been amended to better clarify the terms used to distinguish the four types of data that are collected and analyzed. The *financial data* comprises: (i) quantitative financial data comprising financial numerical data, and (ii) qualitative financial data comprising financial narrative data representing events that financially affect the business entity. Similarly, the *business data* comprises: (i) quantitative business data comprising non-financial numerical data, and (ii) qualitative business data comprising non-financial narrative data representing events related to management and organization associated with the business

entity. Moreover, in order to extract the “narrative data,” event detection and natural language processing is utilized. Thereafter, these four types of data are analyzed and fused to provide the results regarding the business entity.

Applicant submits that the facts do not support a conclusion that the claimed invention is obvious for at least the following reasons and requests withdrawal of the rejections.

Eder in view of *D'Alessandro* does not describe or suggest the four types of data that are extracted and analyzed in accordance with the methods/system of the independent claims. *Eder* describes valuating both tangible and intangible assets to measure financial performance. *D'Alessandro* describes a survey method used to compile the results regarding the performance of the business. There remains, however, a non-obvious gap between these applied references and the invention as claimed. Numerous non-obvious differences exist which cannot be remedied without improper hindsight reconstruction, including the extraction described in the claims of the “narrative data” using event detection and natural language processing and the analysis and fusion of these four types of data to provide the results regarding the business entity. The gap between the cited art and the claimed invention is so great as to render the claims nonobvious to one reasonably skilled in the art.

Applicant further submits that modifying *Eder* in view of *D'Alessandro* would fundamentally alter the method of *Eder* rendering it inoperable for its intended purpose. It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 249 (CCPA 1959). Moreover, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). This is the situation we have here.

Eder describes a method and system for business valuation using both tangible and intangible assets to measure financial performance by extracting financial data concerning revenue, expenses, capital, and elements of value. It does not and would not use any sort of “survey” method as described in *D'Alessandro* to obtain such data. Nor would it have reason to

combine the employee/non-employee survey data with its financial data as that would be irrelevant and/or taint the results.

Accordingly, Applicant requests that the rejection of the independent claims be withdrawn. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them a fortiori and independently patentable over the art of record. Accordingly, Applicant respectfully requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

For the reasons set out above, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and allowance of the application are, therefore, respectfully requested.

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Respectfully submitted,



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